

REMARKS

The specification is objected to as failing to provide antecedent basis for the claimed subject matter in claims 4 and 11. This objection is overcome in view of the cancellation of claims 4 and 11.

Claim 8 is objected to as using terminology inconsistent with terminology used in dependent claims 9-15. This objection is overcome in view of the amendment to claim 8 as suggested, wherein “audio device input/output connector” is amended to --audio input/output connector--.

Claim 11 is objected to for the recitation “blocking cap an at least one”. This objection is overcome in view of the cancellation of claim 11.

Claims 8 and 16 are rejected under 35 U.S.C. §112 as being indefinite for having insufficient antecedent basis. This rejection is overcome in view of the amendment to claim 8 wherein “the circuit” is amended to --a circuit--, as suggested, and in view of the cancellation of claim 16.

Claims 1, 5, 7 and 16 are rejected under 35 U.S.C. §102(b) as being anticipated by *Watanabe et al.* (U.S. Pat. No. 5,675,641). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Claim 1 includes:

1. An apparatus comprising:
 - a first audio input/output connector;
 - at least one second audio input/output connector;
 - an audio controller;

a circuit coupling the first audio input/output connector to the audio controller; at least one circuit coupling at least one second audio input/output connector to the audio controller;

a device electrically decoupling the first audio input/output connector from the circuit coupling the first audio input/output connector to the audio controller when an audio input/output device is coupled to at least one second input/output connector; and

a direct-current blocking cap including a filter circuit coupled with an inverting amplifier, wherein the device is coupled between the direct-current blocking cap and a primary audio input/output coupling.

The PTO provides in MPEP §2131... "To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Watanabe et al.* patent must contain all of the claimed elements of claim 1. However, the claimed combination including the direct-current blocking cap is not shown or taught in the *Watanabe et al.* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, claim 1 and the claims dependent therefrom are allowable.

Claims 2 and 3 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Watanabe* (U.S. Pat. No. 5,675,641) in view of *Fujii et al.* (U.S. Pat. No. 6,128,263). Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Watanabe* in view of *Mackenzie* (U.S. Pat. No. 5,815,352). Claim 6 is rejected under 35 U.S.C.

§103(a) as being unpatentable over *Watanabe* in view of *Fang et al.* (U.S. Pat. No. 6,050,854). Claims 8, 12 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Keene* (U.S. Pat. No. 5,553,220) in view of *Watanabe*. Claims 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Keene* in view of *Watanabe* and further in view of *Fujii*. Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Keene* in view of *Watanabe* and further in view of *Mackenzie*. Claims 13 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Keene* in view of *Watanabe* and further in view of *Fang*. Applicants traverse the rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Claim 8 includes:

8. A computer system, comprising:
 - a processor;
 - a memory coupled to the processor;
 - an audio controller coupled to the processor;
 - a first audio input/output connector coupled to the audio controller;
 - at least one second audio input/output connector coupled to the audio controller;
 - a device electrically decoupling the first audio input/output connector from a circuit coupling the first audio input/output connector to the audio controller when an audio input/output device is coupled to at least one second input/output connector; and
 - a direct-current blocking cap including a filter circuit coupled with an inverting amplifier, wherein the device is coupled between the direct-current blocking cap and a primary audio input/output coupling.

As the PTO recognizes in MPEP §2142:

... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousnessthe Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The references do not teach or suggest the claimed "device electrically decoupling the first audio input/output connector from the circuit coupling the first audio input/output connector to the audio controller when an audio input/output device is coupled to at least one second input/output connector; and a direct-current blocking cap including a filter circuit coupled with an inverting amplifier, wherein the device is coupled between the direct-current blocking cap and a primary audio input/output coupling."

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because none of the references teach or even suggest the desirability of the combination. Moreover, the references do not provide any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

PATENT
Docket: 16356.739 (DC-02368)
Customer No. 000027683

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

Therefore, claims 1 and 8 as well as their respective dependent claims, are allowable.

In view of the above, it is respectfully submitted that remaining claims 1-3, 5-10 and 12-15 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



James R. Bell
Registration No. 26,528

Dated: 7-3-03
HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 512/867-8470

A-149130.1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment. Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on

7/3/03

Date

M/M

Signature

Nishit Pasarya

Typed or Printed name of person signing Certificate